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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING  
2  
3 UNITED STATES PATENT AND TRADEMARK OFFICE  
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5  
6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES  
8

9  
10 Ex parte HERVE BURGAUD,  
11 RUI PEREIRA,  
12 and BEATRICE BELCOUR-CASTRO  
13

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15 Appeal 2009-001991  
16 Application 10/611,968  
17 Technology Center 1700  
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20 Oral Hearing Held: April 21, 2009  
21

22  
23 Before ADRIENE LEPIANE HANLON, JEFFREY T. SMITH, and  
24 JEFFREY B. ROBERTSON, Administrative Patent Judges  
25

26 ON BEHALF OF THE APPELLANT:

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36 ALSO PRESENT:

37 KIMBERLY BRASLOW  
38 CHANG DONG  
39

1           The above-entitled matter came on for hearing on Tuesday,  
2   April 21, 2009, commencing at 9:20 a.m., at the U.S. Patent and Trademark  
3   Office, 600 Dulany Street, Alexandria, Virginia, before Dawn A. Brown,  
4   Notary Public.

5           THE USHER: Calendar Number 22, Appeal Number 2009-  
6   1991. Ms. Herzfeld.

7           JUDGE HANLON: Good morning.

8           MS. HERZFELD: Good morning. How are you?

9           JUDGE HANLON: Good. Would you like to introduce who  
10   you have with you?

11          MS. HERZFELD: Yes, please. With me today, Kimberly  
12   Braslow is a student associate at my law firm, and Chang Dong, who is an  
13   international guest at the law firm. She is the director of the Legal Office  
14   Department at the Chinese State Intellectual Property Office, and she is  
15   currently getting her LLM at American University.

16          JUDGE HANLON: Welcome.

17          MS. HERZFELD: Thank you.

18          JUDGE HANLON: You have 20 minutes. You can begin  
19   whenever you're ready.

20          MS. HERZFELD: Thank you. My name is Deborah Herzfeld,  
21   and I'm appearing for the Appellant in this case. I believe this should be a  
22   very straightforward and quick argument.

23                As you know, the claims 1 through 6, 9 through 10, and 12  
24   through 36 are rejected under 103 as being allegedly obvious over U.S.  
25   Patent Application Publication Hoeffkes, et al., and Benshein as a secondary  
26   reference. The Appellants' argument is that the Examiner has not

1 established a prima facie case of obviousness.

2           The Appellants' contention is that the Examiner's combination  
3 requires too much picking and choosing. Hoeffkes teaches a dyeing  
4 composition that requires a specific enzyme and a dye precursor. The  
5 Examiner contends that Hoeffkes teaches a primary alcohol for an aldehyde  
6 precursor as well as alcohol-reducing enzymes, but these teachings are  
7 secondary considerations in the application.

8           There really isn't any motivation for combining these two  
9 references because the Hoeffkes reference teaches a mechanism where a  
10 phenol-oxidizing enzyme releases an oxygen which then oxidizes the dye  
11 precursor.

12           Benshein, on the other hand, teaches a dye precursor that has to  
13 react with the coupling agent before it is oxidized.

14           So there is no reason that one of ordinary skill in the art at the  
15 time the invention was made would have looked at these two references and  
16 been motivated to then pick and choose these various secondary elements to  
17 arrive at the combination as claimed, which is an aldehyde precursor with an  
18 enzyme to convert to an aldehyde, which then will react with the dye, the  
19 heteroaromatic hydrazone.

20           The Examiner argues that the invention is directed to a dyeing  
21 composition, which is not entirely true.

22           There are process claims that comprise the dye ingredients, talk  
23 about the combined references and they are not -- the claims are not directed  
24 to specific mechanical reactions, chemical reactions, and so that Appellants'  
25 arguments are not relevant.

26           What appellant wants to reemphasize that these arguments are

1 being made for the purpose of showing why there is no motivation to look at  
2 these two different chemical reactions and then arrive at the composition as  
3 well as the processes claimed.

4           If you're looking for a composition that is going to have a  
5 certain chemical reaction on the hair, you are going to need ingredients that  
6 you know are going to cause that reaction and neither of the two cited  
7 references discuss that type of reaction.

8           In addition, the Examiner suddenly at the end of his Answer  
9 makes a statement saying he has a reason to believe the functional language  
10 may be, in fact, an inherent characteristic of the prior art and attempts to  
11 shift the burden onto the Appellants to prove the subject matter is not  
12 inherent.

13           And the Appellants just want to note that that is obviously the  
14 standard for inherency, that the Examiner has to show that certain results or  
15 characteristics must occur and probabilities or possibilities are not sufficient  
16 in showing inherency. That is MPEP section 2112.

17           So in conclusion, KSR does not overturn In re. Rouffett, which  
18 still requires that the Examiner has to show reasons that the skilled artisan  
19 confronted with the same problems as the inventor with no knowledge of the  
20 claimed invention would select the elements from the cited art references for  
21 combination in the manner claimed.

22           So the Examiner hasn't shown why someone -- how someone at  
23 the time the invention was made, attempting to make a composition that  
24 would react with aldehyde precursors on the hair with a dye precursor and  
25 having this dye combination that can be in aqueous form as discussed in our  
26 specification, would look to a reference discussing oxidizing reaction or

1 condensation reaction and then another reference that shows the dye  
2 precursor has to be coupled before it can be oxidized.

3 There is just no basis there.

4 Do you have any questions for me?

5 JUDGE HANLON: Do you have any questions?

6 JUDGE SMITH: It appears that the Examiner is saying  
7 regarding the composition of Hoeffkes that there reactions in addition to the  
8 reaction of the phenol as a dye agent stated in the reference, that there is an  
9 additional reaction that is occurring and your claim does not preclude that  
10 additional reaction.

11 MS. HERZFELD: I mean -- but it is sort of what you would  
12 say would be the reverse of what we've claimed. We have claimed that we  
13 want a composition that will ensure that an aldehyde precursor reacts to  
14 make an aldehyde that will react with the heteroaromatic hydrazone.

15 And what the Examiner is saying is this could possibly be going  
16 on in the background while a dye precursor reacts with the oxygen released  
17 from this oxidative enzyme.

18 JUDGE SMITH: Okay. But based on what, the Examiner is  
19 saying that this reaction could also be present and your composition claims  
20 do not exclude that from being present, that is another reaction also  
21 occurring.

22 MS. HERZFELD: Correct. It doesn't exclude it.

23 JUDGE SMITH: Okay. But it is your position that the  
24 Examiner has not shown that this secondary reaction is actually occurring in  
25 the prior art?

26 MS. HERZFELD: Right. And more to the point that if this is

1 the -- if you're trying to create a composition that you know will have this  
2 reaction on the hair, that really there was no motivation for you to have  
3 looked at the disclosures of these two references to get you to an aldehydic  
4 reaction because they are teaching oxidative condensation on the one hand  
5 and then coupling and then oxidative condensation.

6 So there are two things going on there.

7 JUDGE SMITH: So it is your position that if the two different  
8 references were combined, it is still a different reaction from what you're  
9 claiming in your composition?

10 MS. HERZFELD: There is no guarantee that the reaction that  
11 we're claiming or the composition we're claiming is going to be there.

12 JUDGE SMITH: Okay. I have no further questions.

13 JUDGE HANLON: Thank you.

14 Whereupon, the proceedings at 9:29 a.m. were concluded.